



29 MAR 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

#15

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

WILLIAM E. VAUGHAN  
BELL, BOYD & LLOYD, LLC  
POB 1135  
CHICAGO, IL 60690-1135

In re Application of	:	
CHRISTENSEN et al.	:	
Application No.: 09/806,563	:	DECISION on
PCT No.: PCT/DE99/03101	:	
Int. Filing Date: 27 September 1999	:	RENEWED PETITION
Priority Date: 30 September 1998	:	
Attorney Docket No.: 112740-201	:	UNDER 37 CFR 1.47(a)
For: METHOD FOR TESTING SUBSCRIBER LINES	:	

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed 04 January 2005 in the United States Patent and Trademark Office (USPTO). Applicants' request for four month extension of time is granted. The petition is also being treated as a petition under 37 CFR 1.181 to accept a copy of the 04 January 2005 response in lieu of the original papers.

### **BACKGROUND**

On 17 November 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required. The NOTIFICATION set a two-month extendable period for response.

On 19 April 2004, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration of inventors, the surcharge under 37 CFR 1.492(e), and a statement of facts by Desiree Gobel.

On 29 June 2004, a decision dismissing the petition was mailed to applicants indicating that the declaration was not in compliance with 37 CFR 1.497(a) & (b) and the petition did not provide sufficient proof that the non-signing inventor refused to sign the application.

On 14 March 2005, applicants forwarded, via facsimile, a copy of a response to the decision allegedly filed on 29 December 2004 and received in the USPTO on 04 January 2005.

### DISCUSSION

The original renewed petition under 37 CFR 1.47(a) filed on 04 January 2005 is not located in the application file.

As stated in section 503 of the Manual of Patent Examining Procedure (Rev. 2, May 2004)(MPEP):

A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

A review of the USPTO date-stamped, itemized postcard receipt indicates that the renewed petition (2 pages), request for extension of time (1 page), statement of Ignacio Marc Asperas, Georg Rami and Andreas Winter including Exhibits A-F (22 pages) were deposited with the USPTO on 04 January 2005.

The evidence submitted is sufficient to establish that a response to the 29 June 2004 decision in this application was received in the USPTO on 04 January 2005. The communication filed 14 March 2005 includes a copy of these papers. Accordingly, it is appropriate to accept the copy of the papers as a replacement for the missing original papers with a deposit date of 04 January 2005. The evidence submitted by applicant, the postcard receipt date-stamped by the USPTO, is sufficient to overcome the *prima facie* evidence of the application file itself.

#### Renewed Petition under 37 CFR 1.47(a)

As previously stated, a petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Petitioner has previously satisfied Items (1) and (3).

Although applicant provided the statement of facts of Ignacio Marc Asperas, Georg Rami and Andreas Winter including Exhibits A-F, Item (2) is not yet satisfied. MPEP § 409.03(d) states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application

papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. . . . It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Here, it is not clear that a copy of the application papers including the specification, claims and drawings was sent to Mr. Christensen. The 22 September 2004 letter to Mr. Christensen suggests that only an assignment and a declaration of inventors for the above-identified application were sent to him. A complete copy of the application papers must be provided to the non-signing inventor before it can be concluded that Mr. Christensen is refusing to sign the application papers. It is noted that the "Certified Receipt" (Exhibit F) is illegible and does not provide an indication that the 22 September 2004 letter was received by Mr. Christensen. Additionally, while the statement of facts signed by Mr. Asperas indicates that on 10 September 2004, Mr. Christensen was non-cooperative, no detailed explanation regarding his conclusion of non-cooperation is provided. Applicants have not yet shown that Mr. Christensen has received a complete copy of the application papers and has refused to sign.

Item (4) has not been satisfied. The declaration filed 15 March 2005 is identical to the declaration filed with the 19 April 2004 petition and is not in compliance with 37 CFR 1.497(a)-(b). The declaration includes three "Page 4". As noted in the 29 June 2004 decision, this suggests that all pages of the declaration were not present at the time of execution for each inventor, thus rendering the execution improper. A copy of the entire declaration submitted to applicant(s) for signing must be provided. Each executed declaration must identify all of the inventors and the citizenship, residency and mailing address of all of the inventors. Also, each submitted declaration must be complete, even if executed by only one of the inventors.

### CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

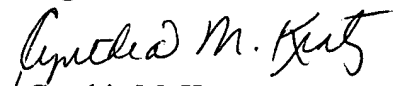
If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT

Application No.: 09/806,563

-4-

Legal Administration.



Cynthia M. Kratz

Attorney Advisor

PCT Legal Affairs

Office of Patent Cooperation Treaty Legal Administration

Telephone: (571) 272-3286

Facsimile: (571) 273-0459